

## REMARKS

The above Amendments and these Remarks are in reply to the Office Action mailed May 16, 2006. Claims 1-69 and 77 were pending in the Application prior to the outstanding Office Action. Claims 70-76 and 79-81 are withdrawn. Claims 1, 7, 9, 26, 43, 58 and 77 have been amended. Support for the amendments is found at least in Figure 1, 2A, 2C, 4C, 5A and in paragraphs [0020], [0022], [0033] and [0036]. Claims 1-69 and 77 remain for the Examiner's consideration. Reconsideration and withdrawal of the rejections are respectfully requested.

## ABSTRACT

The Abstract was objected to because it includes phrases which can be implied. The Abstract has been amended as detailed above. Based on recent CAFC cases, the Abstract can be used "... to determine the scope of the invention, see, e.g., *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1560, 41USPQ2d 1225, 1230 (Fed. Cir. 1997); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 96 F.3d 1409, 1412, 40USPQ2d 1065, 1066 (Fed. Cir. 1996); *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1269, 229 USPQ 805, 810 (Fed. Cir. 1986) ...". *Hill-rom Company, Inc. v. Kinetic Concepts, Inc.*, 209 F.3d 1337, 54 USPQ2d 1437, (Fed. Cir. 2000).

In the amended abstract it is clarified that the phrase "the present invention" relates to an embodiment of the present invention which is then described and as such it communicates important information, i.e., that this is just one embodiment of the present invention and thus not a limitation applicable to determine the scope of the invention. Accordingly, Applicants respectfully request that the objection to the Abstract be withdrawn.

## CLAIM REJECTIONS UNDER 35 U.S.C. § 102

Claims 1-9, 13-26, 30-43, 47-58 and 62-77 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by U.S. Patent No. 5,415,659 to Lee et al. (hereinafter '659).

#### Claim 1

Independent Claim 1 has been amended to include the negative limitation: "where the base is adapted to be hung on the second vertebrae and while being secured by the action of the first end contacting the first vertebrae". Since '659 discloses a base which is secured by three prongs, 34 50 and 24, it does not disclose every element of the Applicant's Claim 1

#### Claim 7

Independent Claim 7 has been amended to include the negative limitation: "wherein the spacer is in contact with the base". Since '659 discloses an element (70) which is interspaced between the spacer and the base, it does not disclose every element of the Applicant's Claim 7.

#### Claim 9

Independent Claim 9 has been amended to include the negative limitation: "wherein the device relies upon pressure exerted by the L5 vertebrae on the distal end of the beam to secure the device to the body". Since '659 discloses a device which does not rely upon pressure exerted by the L5 vertebrae on the distal end of the beam to secure the device to the body, it does not disclose every element of the Applicant's Claim 9.

#### Claim 26

Independent Claim 26 has been amended to include the negative limitation: "wherein the device contacts the beam directly". Since '659 discloses an element (70) which is interspaced between the spacer and the base, it does not disclose every element of the Applicant's Claim 26.

#### Claim 43

Independent Claim 43 has been amended to include the negative limitation: "wherein no additional hooks extend in a direction opposite to the first direction". Since '659 discloses hooks (24) that extend in a direction opposite to the first direction, it does not disclose every element of the Applicant's Claim 43.

#### Claim 58

Independent Claim 58 has been amended to include the negative limitation: "wherein the contact of the beam on the spinous process of the second vertebrae and the hook secure the base to the first vertebrae". Since '659 discloses a device which does not rely upon contact of the beam on the spinous process of the second vertebrae and the hook to secure the base to the first vertebrae, it does not disclose every element of the Applicant's Claim 58.

#### Claim 77

Independent Claim 77 has been amended to include the negative limitation: "wherein the action of the distal end of the spacer on the spinous process of the second vertebrae and the hook secure the body to the first vertebrae". Since '659 discloses a device which does not rely upon the action of the distal end of the spacer on the spinous process of the second vertebrae and the hook to secure the body to the first vertebrae, it does not disclose every element of the Applicant's Claim 77.

Claims 2-6, 8, 13-25, 30-42, 47-57 and 62-69 were rejected to as being dependent on rejected base claims 1, 7, 9, 26, 43 and 58. In view of the above amendments and remarks, applicants respectfully request withdrawal of the rejection of these claims.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 102(b) rejections.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103**

Claims 10-12, 27-29, 44-46 and 59-61 are rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. 5,415,659 to Lee et al. (hereinafter '659).

Claims 10-12, 27-29, 44-46 and 59-61 were rejected to as being dependent on rejected base claims 9, 26, 43 and 58. In view of the above amendments and remarks, applicants respectfully request withdrawal of the rejection of these claims.

In view of the above, Applicants respectfully request that the Examiner reconsider and withdraw the 103(a) rejections.

### CONCLUSION

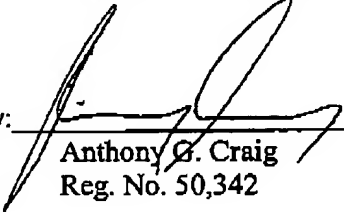
In light of the above, it is respectfully requested that all outstanding rejections be reconsidered and withdrawn. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

No fee is believed due in connection with this paper. However, the Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 7/26/06

By: \_\_\_\_\_

  
Anthony G. Craig  
Reg. No. 50,342

FLIESLER MEYER LLP  
Four Embarcadero Center, Fourth Floor  
San Francisco, California 94111-4156  
Telephone: (415) 362-3800  
Facsimile: (415) 362-2928  
Customer No. 23910  
ACraig@fdml.com